

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the following remarks.

Claims 2, 5, 6 and 32-35 directed to the non-elected species/invention are canceled. Thus, the claims currently pending in this application are Claims 1, 3, 7-15 and 17-31. All of these claims are readable on the elected species and the elected invention. Claims 1 and 3 are the only independent claims.

Independent Claim 1 defines that the guide wire comprises a wire member including a first wire disposed on the distal end side of the wire member and a second wire disposed on the proximal side from the first wire, with the first and second wires each possessing an end face, and the end face of the first wire and the end face of the second wire being welded to one another at a welded portion so that the first and second wires do not axially overlap one another. In addition, a cover layer is provided on the outer periphery of the wire member and covers the welded portion between the first wire and the second wire.

Independent Claim 3 defines the guide wire in a different manner. As set forth in Claim 3, the guide wire comprises a wire member including a welded portion formed by welding a first wire disposed on the distal side of the wire member to a second wire disposed on the proximal side from the first wire. A cover layer is provided on the outer periphery of the wire member and covers the welded portion between the first and second wires. Further, a distal-side cover layer is disposed on the distal side from the cover layer, and is made from a material different from that of the cover layer. The cover layer and the distal-side cover layer do not axially overlap one another.

The Official Action sets forth a rejection of independent Claims 1 and 3 based on the disclosure in one cited reference -- what the Official Action refers to as U.S. Patent No. 5,769,796 to Uchino et al. It is noted that U.S. Patent No. 5,769,796 names *Palermo et al.* as the inventors. Thus, there is an inconsistency in the Official Action with respect to the number of the cited reference and the name of the cited reference. Noting the reference numerals referenced in the Official Action, it is assumed that the anticipatory rejection of independent Claims 1 and 3, and other dependent claims, is based on the disclosure in U.S. Patent No. 6,001,068 to *Uchino et al.*

In setting forth the rejection, the Official Action switches back and forth between different embodiments of the guide wire disclosed in *Uchino et al.* For example, the Official Action notes that *Uchino et al.* discloses a guide wire comprising a first distal wire member 61 and a second proximal member 62. These reference numerals are used in connection with the embodiment of the guide wire illustrated in Figs. 8 and 9. The Official Action also notes that *Uchino et al.* discloses the first wire being welded to the second wire. Here the Official Action refers to Fig. 3(3) of *Uchino et al.* However, this drawing figures represents an embodiment of the guide wire different from the embodiment shown in Figs. 8 and 9. That is, the version of the guide wire illustrated in Figs. 1-3 is one in which the faces of the first and second wires A B are welded to one another. On the other hand, in the embodiment of the guide wire shown in Figs. 8 and 9, the end faces of the two wire members 61, 62 are not welded to one another. This is rather apparent from the description in *Uchino et al.* describing the Figs. 8 and 9 embodiment. In this embodiment, the first wire 61 is joined to a connector 63 by brazing solder 64 as

described in the latter portion of the third full paragraph of column 11 of *Uchino et al.*. In addition, the second wire 62 is also welded to the connector 63 as discussed in the fourth full paragraph of column 14 of *Uchino et al.*. It is thus seen that the embodiment of the guide wire in *Uchino et al.* upon which the Official Action relies (i.e., the Figs. 8 and 9 embodiment) does not include the welded connection shown in Fig. 3(3) of *Uchino et al.*.

Further yet, the Official Action comments that the ends of the first and second wires 61, 62 in *Uchino et al.* are welded to one another without axial overlap of the first and second wires. However, Fig. 9 of *Uchino et al.* clearly shows that the abutting ends of the two wires 61, 62 axially overlap one another by virtue of the angled end surfaces of the two wires at the boundary 68.

The Official Action further comments that the cover layer 63 can be made of a metal with an elastic modulus less than that of the first wire as described in column 3, line 37-column 4, line 65 of *Uchino et al.*, or can be made of a silicone resin as described in column 6, line 19-65 of *Uchino et al.*. Once again, the Official Action seems to be mixing together the disclosures from different embodiments of the guide wire. The discussion beginning in line 37 of column 3 of *Uchino et al.* describes the embodiment of the guide wire shown in Figs. 1-3 which includes a connector 12 that can be fabricated from various plastics and metals. However, this description does not pertain to the cover layer 63 shown in Figs. 8 and 9. Similarly, the discussion beginning in line 19 of column 6 refers to the coating 113 shown in Fig. 1. However, this coating 113 does not cover the welded portion illustrated in Fig. 3 as recited in the independent claims.

Thus, while it appears that the anticipatory rejection is based on the embodiment shown in Figs. 8 and 9 due to the reference to the wires 61, 62, portions of the Official Action raise questions concerning whether this is true. To the extent further communication is required in connection with this application, the Examiner is kindly requested to provide an appropriate explanation for the apparent inconsistency, and is asked to provide clarification about the basis for the rejection.

In the meantime, to more clearly define the guide wire at issue here, independent Claims 1 and 3 are amended to recite that the cover layer is formed such that the wire member is substantially not heated at the time of covering the wire member with the cover layer as described at, for example, paragraph [0110] of the application. As noted above in connection with the embodiment of the guide wire shown in Fig. 8 of *Uchino et al.*, the connector 63, which is said to correspond to the claimed cover layer, is welded to both of the wires 61, 62, meaning that the wire member is heated at the time the wire member is covered with the connector 63 (cover layer).

It is noted also that *Uchino et al.* describes the connector 63 being made of stainless steel as discussed in lines 61-63 of column 13 of *Uchino et al.* Such material is, of course, different from the materials recited in Claims 8, 9, 18 and 19.

New dependent Claim 36 defines that the distal-side cover layer is formed such that the wire member is heated at the time when the wire member is covered by the distal-cover layer. This is also described in paragraph [0110] of the present application. This feature, together with the features recited in independent Claim 3, further distinguishes the claimed guide wire at issue here.

For at least the reasons set forth above, it is respectfully submitted that the claimed guide wire at issue here is patentably distinguishable over the disclosure in *Uchino et al.*.

As the dependent claims in this application are allowable at least by virtue of their dependence from allowable independent claims, a further discussion of additional distinguishing aspects of the guide wire recited in the dependent claims is not set forth at this time.

Early and favorable consideration of this application is respectfully requested.

Should any questions arise in connection with this application or should the Examiner believe that a telephone conference with the undersigned would be helpful in resolving any remaining issues pertaining to this application the undersigned respectfully requests that he be contacted at the number indicated below.

Respectfully submitted,

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